

IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

CONTOUR IP HOLDING, LLC and
ION WORLDWIDE, INC.,

Plaintiff,

v.

GOPRO, INC.

Defendant.

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REDACTED - PUBLIC VERSION

C.A. No. 15-1108-LPS-CJB

LETTER TO THE HONORABLE CHRISTOPHER J. BURKE
FROM ANDREW E. RUSSELL

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Attorneys for Plaintiff

Dated: April 22, 2016

April 22, 2016

BY CM/ECF AND HAND DELIVERY

The Honorable Christopher J. Burke
J. Caleb Boggs Federal Building
844 N. King Street
Wilmington, DE 19801



Re: Contour IP Holding, LLC v. GoPro, Inc., C.A. No. 15-1108-LPS-CJB

Dear Judge Burke:

Pursuant to this Court's April 19, 2016 Oral Order, Plaintiffs Contour IP Holding, LLC ("CIPH") and iON Worldwide, Inc. ("iON") file this letter attaching relevant documents and describing how the attached documents are relevant to the two motions to stay currently pending before the Court (D.I. 10, 14).

The following documents are attached:

■ [Redacted]

■ [Redacted]

- Press Release regarding Intended Merger of Contour, LLC and iON (Tab C)
- CIPH Certificate of Organization (Tab D)

■ [Redacted]

■ [Redacted]

- Assignment of Patents and Patent Applications from Contour, LLC to CIPH (Tab G)

■ [Redacted]

■ [Redacted]

GoPro's Motion to Stay Pending IPR Proceedings

As discussed during the April 19 hearing, and as further detailed in Plaintiffs' responsive brief, the most relevant facts are (1) the PTAB's final written decisions are due no later than October 28, 2016, prior to the beginning of claim construction proceedings in this litigation; (2) the PTAB's final written decisions will not address claims 3-10 of U.S. Patent No. 8,896,694 ("the '694 Patent") or the appropriate constructions of the means-plus-function claim terms contained therein; (3) the discovery that will be conducted between entry of a schedule in this case and the issuance of the PTAB's decision will be relevant to claims 3-10 of the '694 Patent, regardless of the PTAB's decision and (4) iON is not a party to the IPR proceedings.

GoPro's Motion for Costs Pursuant to Rule 41(d)

As discussed during the April 19 hearing, and as further detailed in Plaintiffs' responsive brief, Rule 41(d) requires that the same claim be filed by the same plaintiff against the same defendant—a requirement that is not satisfied here.

Plaintiff iON Worldwide, Inc. was unquestionably not a plaintiff in the Utah Action. Prior to its attempted merger with Contour, LLC (Tab C), iON was a privately-held corporation with the corporate structure depicted and described in Tab A. In connection with the attempted merger, iON took an exclusive license to the patents-in-suit (Tabs H, I), [REDACTED]

Plaintiff CIPH also was not a plaintiff in the Utah Action. [REDACTED]

[REDACTED] The patents-in-suit were assigned from Contour, LLC to CIPH. (Tab G.) [REDACTED]

Third-party Contour, LLC operated separately from iON. (Tab C.) Notably, Mr. Tomaselli had no role in the management of Contour, LLC. (Tab B.) In connection with the attempted merger with iON, Contour, LLC did not retain any separate ownership, license or enforcement rights with respect to the patents-in-suit. (Tab G; Tab F at CONTOUR_IP000074, 76.)

Ultimately, Rule 41(d) is designed to deter vexatious, duplicative litigation. The attached documents reflect a good-faith effort by Plaintiff iON and third-party Contour, LLC to jumpstart the Contour® brand through an attempted merger. As detailed in the Complaint (D.I. 1), once divested of rights in the patents-in-suit, third-party Contour, LLC appropriately dismissed the Utah Action—an action that was stayed prior to any substantive proceedings or the filing of an answer. Plaintiffs CIPH and iON—the owner and exclusive licensee, respectively, of the patents-in-suit at the time this litigation was filed—appropriately filed the instant litigation in the forum of their choosing. (D.I. 1 at ¶ 22.)

Respectfully submitted,

/s/ Andrew E. Russell

Andrew E. Russell (No. 5382)

SHAW KELLER LLP

The Honorable Christopher J. Burke

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cc: All counsel of record (by e-mail)
Clerk of Court (by hand delivery)

Tab A

REDACTED

Tab B

REDACTED

Tab C

iON Merges With POV Camera Company Contour - iON USA

iON Cameras and Contour Announce Merger*Companies join forces to offer broadest range of cutting-edge POV and wearable cameras, with combined global distribution network in over 10,000 storefronts in 40 countries*

MOORESTOWN, NJ and PROVO, UT, May 14, 2015—[iON Cameras](#) and [Contour](#) today announced an agreement in principle to merge the two companies.

The combined organization brings together assets of Contour—a pioneer and innovator in the point-of-view (POV) camera industry that holds critical patents and has a strong international brand—with those of iON Cameras, which brings expertise in engineering and manufacturing, a rapidly increasing line of wireless and wearable cameras, and impressive and growing North American retail distribution.

Industry research firm IDC estimates that POV camera sales will exceed \$2.9 billion by 2018, but this is just one of the categories that the combined organization will be focusing on. The overall addressable market for wearable and connected cameras is expected to be many times larger.

iON Cameras CEO and Founder Giovanni Tomaselli will serve as the new company's CEO. Contour's current CEO James Harrison will assume the role of president.

The Contour and iON brands will co-exist, and together will offer a full range of connected and wearable cameras. Contour will continue to focus on products for the higher end of the camera market, where it has traditionally been a market leader. The joint organization will invest in the innovation of camera hardware as well as in software solutions to enable consumers to shoot, edit, share, live stream and store their video/photo content in the cloud as simply as possible.

The comprehensive product line will include home security solutions; dash cams; tactical and police cameras; tiny, wearable, "lifestyle" cameras; action/adventure cameras; and high-end professional-quality production cameras.

"Our goal is to offer the widest array of easy-to-use, connected cameras in the market, providing a product for every consumer, at every price point," said Tomaselli. "We'll now have resources to continue innovating in key categories while expanding our global presence."

"Contour brings a tradition of innovation and cutting-edge technology to the unbeatable manufacturing capabilities of iON," said Harrison. "Investment in innovation and IP differentiates us from our competitors. Now we will be able to bring great innovations to market much more quickly. The combination of iON and Contour creates a camera company ready for the future of video capture and

live streaming.”

About iON Cameras:

[iON Cameras](#) pioneered the concept of Shoot/Share™ connectivity in point-of-view (POV) cameras with its aerodynamic and fully-waterproof Air Pro, Speed Pro, CamoCam and The Game lines, the iON the Home system, and iON SnapCam, which will be available in summer 2015. iON cameras make it easy to capture and share high-definition video and still images, with Wi-Fi connectivity and free cloud storage.

About Contour:

Based in the heart of Utah’s Wasatch Mountains, [Contour](#) is a pioneer of the Point-of-View (POV) camera market. Contour cameras have been long known as simple to use, dependable products. Defined by a “form follows function” philosophy, Contour cameras feature a sleek, low-profile design, easy to operate controls and a secure and durable proprietary rail connection system. Whether in the water, snow, dirt or flying through the sky, the world’s top adventurers choose to tell their stories using Contour.

Tab D

**CERTIFICATE OF ORGANIZATION
OF
CONTOUR IP HOLDING, LLC**

RECEIVED
JUN 02 2015
Utah Div. of Corp. & Comm. Code

JUN 2 '15 10:43

The undersigned, by executing and delivering to the Division of Corporations and Commercial Code of the Department of Commerce of the State of Utah the following Certificate of Organization, hereby forms a Utah limited liability company in accordance with the Utah Revised Uniform Limited Liability Company Act, as amended, U.C.A. § 48-3a-101 *et seq.* (the "Act"):



**ARTICLE I
NAME**

The name of the limited liability company is "Contour IP Holding, LLC" (the "Company").

**ARTICLE II
REGISTERED AGENT**

The name and address of the Company's initial registered agent is Robert P.K. Mooney, 5152 N. Edgewood Drive, Suite 375, Provo, Utah 84604.

**ARTICLE III
PRINCIPAL OFFICE**

The street address of the Company's principal office is 5152 N. Edgewood Drive, Suite 375, Provo, Utah 84604.

**ARTICLE IV
MANAGER AND OFFICER LIMITATION OF LIABILITY; INDEMNIFICATION**

Except as set forth in the Company's Operating Agreement, the personal liability of the managers and officers of the Company to the Company or its members, as to any third person, will be eliminated or limited to the fullest extent permitted by the Act or any other applicable law as now in effect or as it may hereafter be amended.

Except as set forth in the Company's Operating Agreement, the Company will indemnify and advance expenses to its managers and officers (and their respective estates or personal representatives) to the fullest extent permitted by the Act or any other applicable law as now in effect or as it may hereafter be amended.

Any repeal or modification of this Article IV or the Company's Operating Agreement will not adversely affect any right or protection of any person existing at the time of such repeal or modification.

IN WITNESS WHEREOF, the undersigned has executed this Certificate of Organization effective as of June 1, 2015.

Kenneth A. Kaufman,
Organizer

State of Utah
Department of Commerce
Division of Corporations and Commercial Code
I hereby certify that the foregoing has been filed
and approved on this 2 day of June 20 15
in this office of this Division and hereby issued
This Certificate thereof.

Examiner DK Date 6/10/2015

Kathy Berg
Kathy Berg
Division Director

9434430

Date: 06/02/2015
Receipt Number: 6027168
Amount Paid: \$70.00

Tab E
REDACTED

Tab F

REDACTED

Tab G

ASSIGNMENT OF PATENTS AND PATENT APPLICATIONS

This Assignment of Patents and Patent Applications (this "Assignment") is made effective June 5, 2015, between Contour, LLC, a Utah limited liability company, having its principal place of business at 5152 Edgewood Drive STE 375, Provo, UT 84604 (referred to as "Assignor") and Contour IP Holding, LLC, a Utah limited liability company, having its principal place of business at 5152 Edgewood Drive STE 375, Provo, UT 84604 (referred to as "Assignee").

WITNESSETH:

WHEREAS, Assignor has rights in and owns the patent applications identified in Addendum A attached hereto.

NOW, THEREFORE, for good and valuable consideration, receipt of which is hereby acknowledged by Assignor:

1. Assignor hereby agrees to assign and assigns to Assignee, its successors and assigns, absolutely and forever all its right, title and interest to any and all patents and patent applications (including divisional, continuation, continuation-in-part, §111(b) provisional, §111(a), national phase and reissue applications thereof) owned by Assignor and identified in Addendum A attached hereto, and to any and all rights relating to said patents and patent applications.

2. Assignor further assigns to Assignee all its rights to sue for past infringement of said patents and to recover any and all damages and awards for such infringement.

3. Assignor further covenants and agrees that it will, upon demand of Assignee, its successors or assigns, and without further consideration, execute any and all papers necessary or deemed to be necessary by Assignee or its successors or assigns to be a complete fulfillment of the intent and purpose of this Assignment.

4. Assignor represents and warrants that it owns, and has good and valid title to, all of the patent and patent applications assigned pursuant to this Assignment, which it is assigning to Assignee free and clear of any liens and encumbrances.

5. The patents listed in Addendum A are all the patents and patent applications owned by Assignee.

[Signature page follows]

IN WITNESS WHEREOF, Assignor has caused this instrument to be executed by its duly authorized officers.

Contour, LLC

By  _____
Name: JAMES HARRISON _____
Title: CEO _____
Date: FRIDAY 5TH JUNE 2015 _____

[Signature page to Assignment]

ADDENDUM A

Issued Patents:

Title of Invention:	Country	Status	Application No.	Filing Date	Patent No.	Issue Date	Assignee	Priority	PubNumber	PubDate
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	US	Issued	12/671442	5/14/2010	8,792,041	7/29/2014	Contour, LLC	60/952810	2010-0253826	10/7/2010
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	AU	Allowed	2008282223	2/26/2010			Contour, LLC	60/952810		7/3/2014
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	NZ	Issued	583539	7/30/2008	583539.00	7/2/2013	Contour, LLC	60/952810		
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	NZ	Issued	603337	7/30/2008	603337	9/2/2014	Contour, LLC	60/952810		5/30/2014
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	SG	Issued	201000610-4	7/30/2008	158675.00	7/31/2012	Contour, LLC	60/952810		
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	SG	Allowance forthcoming	201203835-2	7/30/2008			Contour, LLC	60/952810	181398	6/28/2012
PORTABLE DIGITAL VIDEO CAMERA	US	Issued	29/322219	7/30/2008	D616006	5/18/2014	Contour, LLC	-		
PORTABLE DIGITAL VIDEO CAMERA	US	Issued	29/355173	2/3/2010	D621435	8/10/2010	Contour, LLC	29/322219		
BASE MOUNT FOR SECURING A PORTABLE CAMERA	US	Issued	29/356376	2/24/2010	D640304	6/21/2011	Contour, LLC	29/322219		
DIGITAL VIDEO CAMERA	US	Issued	29/367294	8/5/2010	D640722	6/28/2011	Contour, LLC	29/322219		
PLUG MOUNT FOR CAMERA	US	Issued	29/369518	6/28/2011	D665006	8/7/2012	Contour, LLC	29/322219		
CAMERA MOUNT	US	Issued	29/423856	8/7/2012	D689114	9/3/2013	Contour, LLC	29/322219		
CAMERA MOUNT	US	Issued	29/368734	8/27/2010	D663350	7/10/2012	Contour, LLC	-		
SLIDER FOR CAMERA MOUNT	US	Issued	29/422605	7/10/2012	D675242	1/29/2013	Contour, LLC	29/368734		
CAMERA MOUNT	US	Issued	29/439575	12/12/2012	D697127	1/7/2014	Contour, LLC	29/368734		
PORTABLE DIGITAL VIDEO CAMERA CONFIGURED FOR REMOTE IMAGE ACQUISITION CONTROL AND VIEWING	US	Issued	14/268724	5/2/2014	8,896,694	11/25/2014	Contour, LLC	61/382404	2014/0240505 A1	8/28/2014
PORTABLE DIGITAL VIDEO CAMERA CONFIGURED FOR REMOTE IMAGE ACQUISITION CONTROL AND VIEWING	US	Issued	13/822255	9/20/2013	8,890,954	11/18/2014	Contour, LLC	61/382404	2014/0049636 A1	2/20/2014
CAMERA MOUNT	US	Issued	29/423720	6/4/2014	D705338	5/20/2014	Contour, LLC	-	002146746-0002	1/28/2013
CAMERA MOUNT	EP	Issued	002146746-0001	12/3/2012	002146746-0001	12/3/2012	Contour, LLC	29/423720	002146746-0001	1/28/2013
CAMERA MOUNT	EP	Issued	002146746-00010	12/3/2012	002146746-00010	12/3/2012	Contour, LLC	29/423720	002146746-00010	1/28/2013
CAMERA MOUNT	EP	Issued	002146746-00011	12/3/2012	002146746-00011	12/3/2012	Contour, LLC	29/423720	002146746-00011	1/28/2013
CAMERA MOUNT	EP	Issued	002146746-0002	12/3/2012	002146746-0002	12/3/2012	Contour, LLC	29/423720	002146746-0002	1/28/2013
CAMERA MOUNT	EP	Issued	002146746-0003	12/3/2012	002146746-0003	12/3/2012	Contour, LLC	29/423720	002146746-0003	1/28/2013
CAMERA MOUNT	EP	Issued	002146746-0004	12/3/2012	002146746-0004	12/3/2012	Contour, LLC	29/423720	002146746-0004	1/28/2013
CAMERA MOUNT	EP	Issued	002146746-0005	12/3/2012	002146746-0005	12/3/2012	Contour, LLC	29/423720	002146746-0005	1/28/2013
CAMERA MOUNT	EP	Issued	002146746-0006	12/3/2012	002146746-0006	12/3/2012	Contour, LLC	29/423720	002146746-0006	1/28/2013
CAMERA MOUNT	EP	Issued	002146746-0007	12/3/2012	002146746-0007	12/3/2012	Contour, LLC	29/423720	002146746-0007	1/28/2013
CAMERA MOUNT	EP	Issued	002146746-0008	12/3/2012	002146746-0008	12/3/2012	Contour, LLC	29/423720	002146746-0008	1/28/2013
CAMERA MOUNT	EP	Issued	002146746-0009	12/3/2012	002146746-0009	12/3/2012	Contour, LLC	29/423720	002146746-0009	1/28/2013

Pending Patents:

Title of Invention	Country	Status	Application No.	Filing Date	Assignee	Priority	PubNumber	PubDate
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	AU	Pending		10/2/2014	Contour, LLC	2008282223		
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	US	Published	13/674817	11/12/2012	Contour, LLC	60/952810	2013-0063554	3/14/2013
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	CA	Pending	2698281	7/30/2008	Contour, Inc.	60/952810		
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	CN	Published	200880109237.60	7/30/2008	Contour, Inc.	60/952810	101809992	8/18/2010
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	EP	Published	8782542.8	7/30/2008	Contour, LLC	60/952810	2183910	5/12/2010
COMPONENTS OF A PORTABLE DIGITAL VIDEO CAMERA	HK	Published	10110967.6	7/30/2008	Contour, Inc.	60/952810	1144514A	2/18/2011
PORTABLE DIGITAL VIDEO CAMERA	US	Pending	29/454469	5/10/2013	Contour, LLC	29/322219		
CAMERA MOUNT ASSEMBLY	US	Pending	29/478682	1/7/2014	Contour, LLC	29/368734		
PORTABLE DIGITAL VIDEO CAMERA CONFIGURED FOR REMOTE IMAGE ACQUISITION CONTROL AND VIEWING	US	Pending	14/496915	9/25/2014	Contour, LLC	61/382404		
PORTABLE DIGITAL VIDEO CAMERA CONFIGURED FOR REMOTE IMAGE ACQUISITION CONTROL AND VIEWING	EP	Published	11825800.3	9/13/2011	Contour, LLC	61/382404	2617186	7/24/2013
PORTABLE DIGITAL VIDEO CAMERA CONFIGURED FOR REMOTE IMAGE ACQUISITION CONTROL AND VIEWING	CN	Published	2011800454417.00	9/13/2011	Contour, Inc.	61/382404	103210639	7/17/2013
CAMERA MOUNT	US	Aba Intent	29/491197	5/19/2014	Contour, LLC	29/423720		
ACCESSORY CONTROL OF THE ORIENTATION OF THE IMAGE SENSOR OF A PORTABLE DIGITAL VIDEO CAMERA	US	Pending	14/447250	7/30/2014	Contour, LLC	61/861264		
ACCESSORY CONTROL OF THE ORIENTATION OF THE IMAGE SENSOR OF A PORTABLE DIGITAL VIDEO CAMERA	WO	Pending	PCT/US2014/048948	7/30/2014	Contour, LLC	61/861264		
PORTABLE DIGITAL VIDEO CAMERA WITH WATERPROOFING	US	Pending	62/033232	8/5/2014				

Tab H

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Tab I

REDACTED